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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/060,489	01/30/2002	Steven A. Cover	13768.240	6932
47973	7590	02/21/2006	EXAMINER	
WORKMAN NYDEGGER/MICROSOFT 1000 EAGLE GATE TOWER 60 EAST SOUTH TEMPLE SALT LAKE CITY, UT 84111			ENG, DAVID Y	
			ART UNIT	PAPER NUMBER
			2155	

DATE MAILED: 02/21/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/060,489	Applicant(s) COVER ET AL.	
	Examiner DAVID Y. ENG	Art Unit 2155	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 January 2006.
 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12, 14-41 and 43-48 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
 5) ☐ Claim(s) _____ is/are allowed.
 6) ☒ Claim(s) 1-12, 14-41 and 43-48 is/are rejected.
 7) ☐ Claim(s) _____ is/are objected to.
 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
 10) ☒ The drawing(s) filed on 13 January 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Claims 13, 42, have been cancelled. Newly submitted claim 48 has been entered. The active claims are 1-12, 14-41 and 43-48.

There are a total of 46 claims in the application and the claim language is so broad that the Examiner is unable to ascertain the support of the claim limitations in the specification. For example, it is not seen how Figure 1 is related to the independent claims. Figure 1 shows a mobile phone. Figure 1 is purported to provide a general description of a suitable computing environment in which the invention may be implemented. See the description in [0031] and [0032]. The description of the mobile phone on pages 12-15 does not indicate whether it is a requesting computer system, a consumer module, a configuration computer system or all three. Applicants are therefore requested to (1) identify the support of each of the claims and (2) set forth the structure, material or acts described in the specification as corresponding to each claimed function with reference to the specification by page and line number, and to the drawings by reference characters so that the Examiner is able to correlate the teaching of the applied references to Applicants' claims in his Office action.

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 43-46 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The disclosure on page 11 does not preclude that instruction carrier could be a carrier wave. The rejection can be overcome by inserting "stored in a tangible storage" after "computer-executable instruction" in line 6 of independent claims 43 and 45.

Claims 1-48 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In line 3 of claim 1, it appears that "the services" (first occurrence) should be deleted because the preamble should read "—causing configuration information --- to be received at consumer modules —". All other independent claims have similar defect.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1-12, 14-41 and 43-48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lalwaney (USP 6,289,377).

With respect to independent claims 1, 22, 25, 43 and 45, see at least the title, the abstract, Figures 1 and 8 and the description thereof in Lalwaney. Lalwaney teaches a method, system and program product for automatically causing configuration information (see "configuration information" in the last 2nd and the last 6th line of the abstract) associated with the services (broadband service) of a service provider (broadband service provider) to be received at consumer modules (cable modem 122 of client PC 120) that consume the services, so as to reduce the amount of configuration information manually entered by a user (see the last line of the abstract), comprising the following:

an act of the requesting computer system (see the "request" and PPRA in lines 12-13 of the abstract) accessing an identifier representative of services the consumer modules will consume;

an act of the requesting computer system (see the "request" and PPRA in lines 12-13 of the abstract), automatically, and without user intervention, causing a search for configuration information associated with the services the consumer modules will consume;

an act of accessing the configuration information resulting from the search (cable network address server retrieves configuration information, see lines 15-18 of the abstract); and

an act of the consumer modules (cable modem) receiving the accessed configuration information (see the last sentence of the abstract).

Lalwaney does not appear to teach that the configuration information includes an identification of a service provider. No patentable weight is given to including a service provider identifier in configuration information because the service provider identifier as recited is nothing but part of the data within the configuration data which has no specific function in providing configuration information. Official Notice is taken that service provider identifier is well known in the art at the time of invention. It would have been obvious to a person of ordinary skill in the art to provide a service provider identifier in the configuration information if that is needed or useful in configuration.

With respect to the dependent claims directed to using a portion of an email address or an identifier to represent services the consumer modules will consume such

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as email and news group service, Official Notices is taken that at the time of invention, email and news group services, etc. are well known in the art. It would have been obvious to a person of ordinary skill in the art to provide the requesting computer system whatever it needs to access the proper configuration information in accordance with the identifier chosen to represent the service consumed by the consumer module. Note that the email address as recited has no function other than acting as an identifier representing a service to be consumed by a consumer module.

With respect to the dependent claims directed to retrieving the configuration information, note that Lalwaney also requires configuration information to be retrieved and forwarded to the consumer module. How exactly the configuration information is indexed to be retrieved is a matter of design choice. It would have been obvious to a person of ordinary skill in the art to store the configuration information in a system in such a way that the configuration information could be retrieved in accordance with an identifier chosen to represent a service.

On page 18, Applicants rely on the newly inserted limitation for patentability. It is not clear what applicants mean by “unaware of an identification of a service provider” and why that limitation is patentable over Lalwaney. Note that the consumer module is aware that configuration information associated with a service is transmitted to it and that the service is going to be provided by the service provider. Note further that the transmitted configuration information includes the identification of a service provider. The consumer module appears to be aware of the service provider although may not this particular identification number. If “aware” means that the transmitting of

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configuration information does not require the identification of the service provider, in Lalwaney, the cable modem is not required to be aware of an identification of the service provider so long if the cable modem does not require the identification for downloading configuration data. In conclusion, whether or not the consumer module is aware of an identification number is immaterial so long if it is able to receive the configuration data. No inventive concept is seen from the claims with respect to Lalwaney.

With respect to the remarks directed to claims 16, 31, 38, 17, 18, 34, 39, 32, 33, 41, 47 and 48, Applicants merely restate what is in the claims. Applicants fail to set forth why they are patentable distinct over Lalwaney. In re Nielson, 816 F.2d 1567, 2 USPQ 1525 (Fed. Cir. 1987). The court held that simply pointing out what a claim requires with no attempt to point out how the claims patentably distinguish over the prior art does not amount to a separate argument for patentability.

With respect to claims 16, 31 and 38, if the configuration information is organized into a table, obviously a search computer would search a table of configuration information.

As to claim 17, if the configuration information is scattered among a plurality of configuration computer system, a search of the configuration information obviously requires a search of a configuration computer system. No inventive concept, improvement, or patentable distinct is seen.

As to claims 18, 34 and 39, information in XML is well known in network art. This is a markup language used for document on the World Wide Web. The document in Lalwaney is coded in markup language also. See lines 10-15 of column 13 in Lalwaney.

As to claims 32 and 33, if the configuration is stored in another remote computer, in order to retrieve the configuration information from the remote computer, one of ordinary skill in the art obviously would associate the configuration information with the identifier of the remote computer. No inventive concept is seen.

As to claim 41, system bus is inherent in a computer system.

As to claim 47, whether or not the configuration computer system is external to a service provider is not a patentable distinct subject matter.

As to claim 48, using an address to identify a business entity to receive mail is a well known practice.

Applicant's arguments filed 1/5/2006 have been fully considered but they are not persuasive.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DAVID Y. ENG whose telephone number is 703-305-9691. The examiner can normally be reached on M-F from 7AM to 3PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Saleh Najjar, can be reached on 571-272-4006. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for

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published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'D. Eng', with a stylized, flowing script.

DAVID Y. ENG
PRIMARY EXAMINER